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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,429	10/28/2003	David Mathieu	AUC-32815-1	9460

56080 7590 11/29/2007
WHYTE HIRSCHBOECK DUDEK S.C.
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Madison, WI 53703-4655

EXAMINER

NGUYEN, PHONG H

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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11/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/695,429

Applicant(s)

MATHIEU ET AL.

Examiner

Phong H. Nguyen

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 23, 26 and 28-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-22, 24, 25, 27 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.84 (b)(1) since there are some photographs in the drawing section. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (e.g., immunological, western, Southern, and northern), auto-radiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable.

Specification

2. The Specification is objected to under 37 CFR 1.71 because it does not describe the mechanical structure of the actuator that allows the actuator to move the cutting blade into a cutting position or a non-cutting position. The Specification only describes the actuator of the non-elected species in Figs. 2-6. It does not seem that the actuator of the non-elected species in Figs. 4-6 can be used in the elected Species in Fig. 1.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 19-22, 24, 27 and 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear how the actuator in the rotary trimmer in Fig. 1 can move the cutting blade into a cutting position or a non-cutting position. It is to be noted that Fig. 1 does not show any actuator. There is no indication that the actuator in the non-elected species can be bodily incorporated into the rotary trimmer in Fig. 1. For example, the actuator 28 of the non-elected species in Fig. 4 is provided in the midsection of the elongated handle 22. A user wraps his finger around the handle 22 and uses his index finger to squeeze the actuator 28. If the actuator 28 of the non-elected species in Fig. 4 is incorporated into the elected species in Fig. 1, a user cannot wrap his finger around the handle 22 and use his index finger to squeeze the actuator 28. Therefore, the actuator in Fig. 4 does not work in the rotary trimmer in Fig. 1.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 19-22, 24, 27 and 36-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 19-22, 24, 27 and 36-39, it is unclear how an actuator in the rotary trimmer in Fig. 1 can move the cutting blade into a cutting position or a non-cutting position.

Claim 27 calls for the actuator 28 interacting with the fastener 43. It is unclear how the interaction between the actuator 28 and the fastener 43 can happen since the actuator 28 and the fastener 43 appears to be spaced apart.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 19-22, 24, 25, 27 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Brening (957,409).

Regarding claim 19, Brening teaches a rotary trimmer comprising a blade carriage (a), a blade guard assembly (a2) having a cutting blade (b) indirectly secured to the blade guard, and a blade guard assembly fastener (the screw on the right side in Fig. 2) for removably connecting the blade guard assembly to the blade carriage. See Figs. 1-4.

Regarding claim 20, the handle (a10) being an arcuate pad is best seen in Figs. 1-2.

Regarding claim 21, an actuator (a6, a4 and a1) that selectively positions the cutting blade between an operative position and an inoperative position is best seen in Figs. 1-2.

Regarding claim 22, the actuator (a6, a4 and a1) slidably positioning the cutting blade is best seen in Fig. 1.

Regarding claim 24, a clip is the screw that secures the blade to the blade guard assembly. See Fig. 2.

Regarding claim 25, a handle (a10) of the blade carriage is best seen in Figs. 1-2.

Regarding claim 27, the blade guard assembly fastener located on element (a) and element (a) moves up or down due to the actuator (a6, a4 and a1). Therefore, the blade guard assembly fastener is considered indirectly interacting with the actuator.

Regarding claim 36, Brening teaches a rotary trimmer comprising a cutting blade (b), a blade guard assembly (a) having a cutting blade secured thereto, and a blade carriage (a2) for carrying the blade guard assembly. See Fig. 1-4.

Regarding claim 37, the rotary trimmer being connected to a cutting board having a rail is best seen in Fig. 4.

Regarding claim 38, Brening teaches a rotary trimmer comprising a blade carriage (a2), a fastener (the screw on the right side in Fig. 2) situated on the blade carriage, a blade guard assembly (a) having a cutting blade secured thereto, and an actuator (a10) for moving the cutting blade (b) between an operative position and an inoperative position,

wherein the blade guard assembly is readily removed from the blade carriage. See Figs. 1-4.

9. Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Boda et al. (5,299,355), hereinafter Boda.

Boda teaches a rotary trimmer comprising a blade carriage (42), a fastener (18) situated on the blade carriage, a cutting blade (14) received on the fastener (18), a guard (60) covering the cutting blade and secured to the cutting blade, and a handle (12) on the blade carriage. See Fig. 3

10. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Ridgely (909,227).

Ridgely teaches a rotary trimmer comprising a blade carriage (1), a blade guard assembly (13 and 19) having a cutting blade (26) secured to the blade guard, and a blade guard assembly fastener (4) for removably connecting the blade guard assembly to the blade carriage. See Figs. 1-4.

Response to Arguments

11. Applicant's arguments with respect to the objection to the drawings and the specification, and the rejection under 35 U.S.C. 112, 1st paragraph, have been fully considered and are persuasive. The objection to the drawings and the specification, and the rejection under 35 U.S.C. 112, 1st paragraph, have been withdrawn.
12. Applicant's arguments with respect to claims 19-22, 24, 27 and 36-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy V Eley/
Primary Examiner, 3724

PN:



November 13, 2007